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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/696,148
Filing Date: October 29, 2003
Appellant(s): LEE, ENG-KEONG

Michelle Whittington
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed July 10, 2008 and June 23, 2008 appealing from the Office action mailed September 19, 2007.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is substantially correct. The changes are as follows: Whether applicant's claims are anticipated by the Mullaly reference under 35 USC 102(e).

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

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(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 2, 4-9 and 11-18 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,553,341 B1 to Mullaly et al.

As concerns claim 1, an endpoint status notification system for use in a telecommunications network, the system comprising: an address book (col. 7, line 2) comprising a plurality of network user's names (names in address book) and their associated endpoints (address); a personal list of contacts comprising the users selected from the address book by one of the users (users selected from book and inserted into a message send to line); an instant message alert (col. 2, lines 36-43; fig. 8, 802) received by said one user upon every occurrence of a reportable event for the contacts on the list, the alert comprising one of a plurality of viewable (col. 7, line 25, 34; col. 8, lines 53-54; fig. 8, 802-visual notification) informational status messages pertaining to the contact and delivered to said one user unbeknownst to the contact (col. 7, line 30; col. 8, lines 23-24), the reportable event being selected by said one user for each of the contacts on the list, whereby the reportable events

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received by said one user may differ for each of the contacts on the personal list (col. 10, lines 10-13); and a viewable call-control option received by said one user simultaneous with the instant message alert and selection of said option causes a telecommunication function related to the reportable event and pertaining to the contact to immediately occur (figure 8; column 8, lines 3-13; fig. 6, 626).

As concerns claim 2, wherein said instant message alert comprises a popup window on a display of an endpoint of said one user (col. 8, lines 53-56).

As concerns claim 4, the system of claim 1, wherein one of the contacts on the personal list comprises said one user, thereby said one user receiving the instant message alert for every occurrence of reportable event for said one user (column 8, lines 27-29).

As concerns claim 5, the system of claim 1, wherein the instant message alert is received for a preset amount of time to be determined by said one user (col. 7, lines 30; users selection may vary in length of time).

As concerns claim 6, the system of claim 1 further comprising a log of the reportable events for said one user and viewable by said one user sometime after the event occurs (504).

As concerns claim 7, the system of claim 1, wherein the personal list of contacts further comprises a textual display of a current status of the contacts, the list being viewable by said one user and updated immediately following a reportable event, whereby said one user is able to view a real-time status of the contacts (col. 6, line 63-col. 7, line 2).

As concerns claim 8, the system of claim 1, wherein said one user proxies another user to receive the instant message alerts intended for said one user (figure 7, forwarding).

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As concerns claim 9, a method of endpoint status notification system in a telecommunications network comprising a plurality of users, the method comprising: selecting a list of personal contacts from an address book (col. 6, line 63-col. 7, line 2) comprising names (names in address book) and endpoints (address) belonging to the users; for each of the contacts, choosing one or more telephony-related reportable events associated with the contact (figure 8), whereby the reportable events for each contact may differ (col. 10, lines 10-13); receiving a message alert instantaneously upon occurrence of the telephony-related reportable event and transmitted unbeknownst to the contact (col. 7, line 30; col. 8, lines 23-24); viewing the alert comprising an informational message (fig. 6; col. 8, lines 53-56) and a call-control option (fig. 6, 626), both pertaining to a real-time status of one of the contacts (figure 8); selecting the call-control option (fig. 6, 626) to initiate a telephony-related function to the contact (column 8, lines 3-13).

As concerns claim 11, the method of claim 9, wherein viewing the alert comprises viewing a popup window (col. 8, lines 53-56) for a pre-determined time limit (time determined by user until they close the window).

As concerns claim 12, the method of claim 9 further comprising viewing a menu of telephony-related reportable events (figure 7) for each contact prior to choosing the reportable events.

As concerns claim 13, the method of claim 12 further comprising viewing the list of personal contacts and a real-time status of each contact displayed near each name (col. 6, line 63-col. 7, line 2).

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As concerns claim 14, a method for status notification in a telecommunications network comprising a plurality of endpoints, the method comprising: detecting a change in status of a monitored endpoint (col. 2, lines 36-43); determining if the change is an identified reportable event for the monitored endpoint (col. 2, lines 36-43; figures 7 and 8); if the change is the identified reportable event, then immediately transmitting a status alert to a user, unbeknownst to the monitored endpoint (col. 7, line 30; col. 8, lines 23-24), requesting notification of the identified reportable event (col. 5, line 66); transmitting, simultaneous with the status alert, one or more viewable call processing commands related to the identified reportable event and the monitored endpoint (column 8, lines 3-13; fig. 6, 626); and processing the call command associated with the monitored endpoint (figure 6; col. 7, line 61-col. 8, line 13).

As concerns claim 15, the method of claim 14, wherein determining comprises comparing the change to a pre-selected and stored reportable event for the monitored endpoint (column 8, lines 23-40).

As concerns claim 16, the method of claim 14, wherein transmitting a status alert comprises transmitting and displaying a popup window (col. 8, lines 53-56).

As concerns claim 17, the method of claim 14, further comprising causing an audible alert (col. 5, line 66) to indicate the identified reportable event.

As concerns claim 18, the method of claim 14, wherein reportable events vary for each monitored endpoint (col. 10, lines 10-13).

(10) Response to Argument

The Appellant argues Mullaly fails to disclose a viewable call-control option received simultaneous with the alert (Brief p. 7, 2nd paragraph, lines 1-2).

The claims have been given the broadest reasonable interpretation and Mullaly discloses a viewable call-control option received simultaneous with the alert at least at col. 7, lines 20-41, wherein an audible alert and viewable “call-control option” are displayed simultaneously. When a message is received an audible alert and a “pop-up” window will be brought to the top simultaneously (see at least col. 8, lines 49-56; fig. 8-802-visual notification). Thus Mullaly does disclose this claim limitation.

The Appellant further states the applicant’s specification sets forth “a call control option” is provided to the user so that the user can immediately respond to the message alert with a telecommunication function related to the event (Brief p. 7, 2nd paragraph, lines 3-5).

Mullaly discloses at least at col. 8, lines 49-56 wherein the “window” is brought to the top, thus the user can immediately respond to the alert with a telecommunication function, such as a message reply (col. 8, lines 8-9; fig. 6, 626). The claims do not set forth what comprises a “telecommunication function” or how the user “responds”. The claims have been given the broadest reasonable interpretation and limitations from the specification are not read into the claim. Mullaly anticipates the claim limitations, since sending mail is a “telecommunication function” that is a “response” to a related event (incoming message/alert). Email uses telecommunication infrastructure and is therefore a “telecommunication function” which is communication from a distance.

The Appellant states the pop-up alert may appear after the user selects the call control option and the different call control options include “hangup”, “leave message” and “send to voicemail” (Brief p. 7, 2nd paragraph).

The appellants recite a pop-up window in Claims 2, 11 and 16. The claims are given the broadest reasonable interpretation and the pop-up window of claims 2, 11 and 16 is at least disclosed at col. 8, lines 53-56 of Mullaly.

However, it is noted that these features upon which applicant relies, the different call control options include “hangup”, “leave message” and “send to voicemail” are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). If such features are of pertinent importance to be identified in the appellant’s arguments to give meaning to broad claim terminology and distinguish over the prior art, it is unclear why they are not present in the claims. The term “call control option” has not been given a narrow interpretation as argued by the appellant but given the broadest reasonable interpretation.

The Appellant argues Mullaly is a system for announcing the receipt of an email message, such as by synthesized speech (Brief page 8).

In response to Appellant's argument that Mullaly includes additional structure, synthesized speech, not required by Appellant's invention, it must be noted that Mullaly discloses the invention as claimed. The fact that it discloses additional structure not claimed is irrelevant.

The Appellant further states the problem Mullaly attempts to correct. It has been held that the mere fact that the references relied on by the Patent and Trademark Office fail to evidence an appreciation of the problem identified and solved by applicant is not, standing alone, conclusive evidence of the nonobviousness of the claimed subject matter. The references may suggest doing what an applicant has done even though workers in the art were ignorant of the existence of the problem. In re Gershon, 152, USPQ 602 (CCPA 1967).

The Appellant further argues Mullaly discloses an audible notification. The Examiner agrees that Mullaly does disclose an audible notification. However the notification/alert also includes a viewable “pop-up” window providing **visual** indication (Mullaly, at least col. 8, lines 53-56).

The Appellant argues the Mullaly “alert” is clearly an audible announcement of the receipt of an email message and the message text is filtered and transformed into speech (Brief p. 9, 1st paragraph).

The Examiner disagrees since the Appellant is taking a narrow interpretation of both the claims and the prior art reference. Mullaly does disclose an audible announcement that would satisfy as an alert. However the alert of Mullaly also includes a viewable “pop-up” window providing **visual** indication (Mullaly, at least col. 8, lines 53-56; fig. 6) which satisfies the claim limitation of being “viewable”. The viewable call-control option of Mullaly may comprise a send mail button (col. 8, line 8; fig. 6, 626), which is viewable on a user's display screen (fig. 1).

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The Appellant argues “Sending mail” is referring to sending an email message to a contact and this is not similar to selecting a “call-control option” (Brief p. 9, 2nd paragraph, lines 9-10).

The claims have been given the broadest reasonable interpretation and the appellant appears to be applying a narrow interpretation to the “call-control option” which is not supported by the claims. The claims limit the scope of the term “call-control option” via its function (as in Appellant’s claim 9) that it “initiate a telephony-related function”. Mullaly discloses a send mail button (col. 8, line 8; fig. 6, 626), which would also “initiate a telephony-related function”, via sending an email message. Thus since the structure of Mullaly’s send mail button performs the same function as appellant’s “call-control option” since it initiates a "telephony-related function" since the email would use telephony infrastructure for communicating. Furthermore Mullaly discloses text voice messages (col. 8, lines 3-8) and email employing speech which are “telephony-related”.

The appellant argues the “send mail” is not available simultaneous with the message alert (Brief p. 10, lines 3-4).

The Examiner disagrees since Mullaly discloses the message alert will include a “pop-up” viewable window (Mullaly, fig. 6; col. 8, lines 53-56) that displays the send mail button (fig. 6, 626) in addition to an audible sound. Thus the “send mail” is available simultaneously with the message (col. 8, lines 53-56; fig. 8-visual notification option).

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(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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